

Notice of Allowability

Application No.

09/529,715

Applicant(s)

OHASHI ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/3/05.
2. ☒ The allowed claim(s) is/are 89, 114 and 116-118.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Paul S. H.
AU 1616

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Warren Cheek on August 30, 2006.

1) In claim 89, line 8 after "5.6," please insert "wherein the acidic substance is a member selected from the group consisting of citric acid, tartaric acid, maleic acid, and phosphoric acid, and".

The claim should read as follows:

89. A fast-dissolving pharmaceutical composition in a solid dosage form, comprising micronized (R)-2-(4-bromo-2-fluorobenzyl)-1,2,3,4-tetrahydropyrrolo[1,2-a]pyrazine-4-spiro-3'-pyrrolidine-1,2',3,5'-tetrone (hereinafter referred to as "AS-3201") having a mean particle size of in a range of about 1.5 μm to less than about 10 μm in a ratio of about 0.5% by weight to about 25% by weight of the total weight of the pharmaceutical composition, and as a stabilizer at least one acidic substance having a pKa less than about 5.6,

wherein the acidic substance is a member selected from the group consisting of citric acid, tartaric acid, maleic acid, and phosphoric acid, and

wherein when in a dissolution percentage of AS-3201 from the composition is measured according to the Paddle method, 50% or more of the AS-3201 in the composition is dissolved with 15 minutes from the start of the method.

2) Cancel claim 90.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The closest prior art, US 5,258,382 to Negoro et al, is directed to a pharmaceutical composition comprising AS-3201 and excipients. Although Negoro et al teach excipients that are suitable for formulating the dosage form, Negoro does not disclose or suggest the incorporation of a stabilizing acid with a pKa of less than 5.6.

US 5,356,636, to Schneider et al, teach the incorporation of acids to stabilize active agents that are sensitive to oxidation, such as vitamin and carotenoid products.

However, there is no motivation for a skilled artisan to combine Negoro et al and Schneider et al and utilize the instantly claimed acids to stabilize AS-3201, *in particular*, since 1) Negoro does not disclose or recognize that AS-3201 has stability problems or is sensitive to storage factors such as oxidation and 2) Schneider is directed to stabilizing *vitamins*, which are structurally different from the claimed compound, AS-3201. Thus, the prior art of record, alone or in combination, does not fairly teach or suggest the incorporation of an acid with a pKa of less than about 5.6 to specifically stabilize the compound AS-3201.

Furthermore, the Rule 132 (E) Declaration filed 6/1/05 demonstrates the *significant* inhibition of AS-3201 degradation in formulations comprising acids having a pKa value of below 5.6 compared to formulations without the stabilizing acid.

The terminal disclaimer filed on 11/3/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,297,244 has been reviewed and is accepted and therefore overcomes the obviousness-type double patenting rejection of record. Copending application 11/498147 filed 8/3/06 is made of record and the examiner notes MPEP 804 I (B) 1 regarding any potential obviousness-type double patenting rejections.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sharmila S. Gollamudi

Examiner

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